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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/651,875	08/30/2000	John Underwood	730301-2016	1909
20999	7590	09/07/2006	EXAMINER	
FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			CAMPBELL, JOSHUA D	
			ART UNIT	PAPER NUMBER
			2178	

DATE MAILED: 09/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/651,875

Applicant(s)

UNDERWOOD ET AL.

Examiner

Joshua D. Campbell

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-15, 26-28, 35-39, 50-52, 54 and 56-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-15, 26-28, 35-39, 50-52, 54 and 56-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Amendment filed 6/5/2006.
2. Claims 9-15, 26-28, 35-39, 50-52, 54, and 56-58 are pending in this case.

Claims 9, 26, 35, 50, 54, 56, and 57 are independent claims. Claims 9, 26, 35, 50, 54, and 56 have been amended.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 56 remains rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The data structure (i.e. set of computer program instructions) of the claims is not embodied on a computer readable medium.

Regarding claim 56 the MPEP states:

Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure

and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 9-15, 26-28, 35-39, 50-52, 54, and 56-58 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Currently all of the independent claims have amended limitations that pertain to defining one or more other pages of one or more other web sites which the user does not have authority to edit to include a link to the presented page. This type of limitation is then followed by a limitation that pertains to placing a link on at least one of the other pages of the one or more other web sites linking to the presented page. These two limitations as currently presented in the claims contradict each other thus providing a lack of enablement within the claims. It is completely unclear how a user would complete the latter of the two limitations discussed, i.e. placing the link, when the claim actually states in the earlier limitation that the user does not have the authority to accomplish this step. It is unclear if there is a remedy to this problem in the specification, at this point the examiner cannot locate

any evidence of how the current claimed embodiment could accomplish the steps based on the specification. However, even if some possible explanation of how this embodiment would be carried out in the specification it would be necessary to move these steps into the claims because they would be considered to be essential steps for the claimed invention to properly work.

In order to further prosecution, the amendment of "...which the user does not have the authority to edit," will not be taken into account due to the fact that it renders the claims not functional and thus not enabled. Proper correction is required.

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 9-15, 26-28, 35-39, 50-52, 54, 56 and 57 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Dozier et al. (US Patent Number 6,393,469, filed on March 28, 1995) in view of Gentner (US Patent Number 5,724,595, filed on June 19, 1996).

Regarding independent claim 9, Dozier et al. discloses a method in which a page of a web site (unit of multimedia information) is presented and a suggested list of pages, these pages all being currently accessed by the system and thus being valid (either local to the website, same WAN, or from another website, different WAN) that should be linked to that page are generated (column 4, lines 8-33 of Dozier et al.).

Dozier et al. also discloses method of placing a hyperlink on a document residing on a WAN server without viewing it (column 4, lines 8-33 of Dozier et al.). Dozier et al. does not disclose that a link from the presented page being viewed should be placed on a target page. However, Gentner discloses a method in which a link to a presented page may be automatically created on any chosen target page (column 1, lines 55-67 of Gentner). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the method of automatically placing links and suggesting pages to link to of Dozier et al. and the method of linking a target page to a viewed page of Gentner because it would have allowed a link to generated on a target page to a presented page in a way that would have allowed the user to specify the location of the hyperlink.

Regarding dependent claim 10, Dozier et al. discloses a method in which once a list of pages that would be relevant to be linked to the presented document, the user is presented with a prompt, which is used to decide if links should be created between the two documents (column 14, lines 48-67 of Dozier et al.).

Regarding dependent claims 11-13, Dozier et al. discloses a method in which a page would be presented on a digital computer (multi-purpose input-output device) with multiple I/O peripherals that is connected to Wide area network, which would include a portable computer (laptop i.e. wireless device) (column 5, lines 35-45 of Dozier et al.).

Regarding dependent claim 14, Dozier et al. discloses a method in which a list of pages that would be relevant (based on language processing techniques) to be linked

to the presented document is presented to the user (column 4, lines 9-18 of Dozier et al.).

Regarding dependent claim 15, Dozier et al. discloses a method in which pages that are relevant are grouped into categories that they share in common (i.e. author, language, etc.) (column 14, lines 48-67 of Dozier et al.).

Regarding independent claim 26, Dozier et al. discloses a method in which a page of a web site is presented and a suggested list of pages, these pages all being currently accessed by the system and thus being valid (either local to the website, same WAN, or from another website, different WAN) that should be linked to that page are generated (column 4, lines 8-33 of Dozier et al.). Dozier et al. does not disclose that a link from the presented page should be placed on target pages. However, Gentner discloses a method in which a link to a presented page may be automatically created on any chosen target pages (column 1, lines 55-67 of Gentner). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the method of Dozier et al. and the method of Gentner because it would have allowed a link to generated on target pages to a presented page more efficiently.

Regarding dependent claim 27, Dozier et al. discloses a method in which the links in a collection of pages are modified if a navigation characteristic (changing the location or setting access controls) of a page is modified (column 4, lines 18-33 of Dozier et al.).

Regarding dependent claim 28, Dozier et al. discloses a method in which once a list of pages that would be relevant to be linked to the presented document, the user is

presented with a prompt, which is used to decide if links should be created between the two documents (column 14, lines 48-67 of Dozier et al.).

Regarding independent claim 35 and dependent claims 36-39, the claims incorporate substantially similar subject matter as claims 9-15. Thus, the claims are rejected along the same rationale that is presented in the rejection of claims 9-15.

Regarding independent claim 50 and dependent claims 51-52, the claims incorporate substantially similar subject matter as claims 26-28. Thus, the claims are rejected along the same rationale that is presented in the rejection of claims 26-28.

Regarding independent claims 54 and 56, the claims incorporate substantially similar subject matter as claims 9. Thus, the claims are rejected along the same rationale that is presented in the rejection of claim 9.

Regarding independent claim 57, Dozier et al. discloses a method in which a page of a web site (referral page) is presented and a suggested list of information which correlates to other web publications topically related to the first page that the system believes should be linked to that page are generated, these publications all being currently accessed by the system and thus being valid (column 4, lines 8-33 and column 13, line 55-column 14, lines 67 of Dozier et al.). This topical list is based on the language found in the original page which can be based on author, topic, keyword, organizations (business names), and other data that could be compared between the first document and the list of second documents (Figures 8a-8b and column 13, line 55-column 14, lines 67 of Dozier et al.) Dozier et al. also discloses that the user may select one of the items from the list and create a referral (link) from the first website to the

second website selected based on the correlated list item (column 4, lines 8-33 and column 13, line 55-column 14, lines 67 of Dozier et al. of Dozier et al.). Dozier et al. does not disclose that a link from the presented page being viewed should be placed on a target page. However, Gentner discloses a method in which a link to a presented page may be automatically created on any chosen target page (column 1, lines 55-67 of Gentner). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the method of automatically placing links and suggesting pages to link to of Dozier et al. and the method of linking a target page to a viewed page of Gentner because it would have allowed a link to generated on a target page to a presented page in a way that would have allowed the user to specify the location of the hyperlink.

8. Claim 58 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Dozier et al. (US Patent Number 6,393,469, filed on March 28, 1995) in view of Gentner (US Patent Number 5,724,595, filed on June 19, 1996) as applied to claim 57 above, and further in view of Dutta (US Patent Number 6,775,208, filed on November 4, 1999).

Regarding dependent claim 58, neither Dozier nor Gentner disclose a that the operator of the website which is to be linked to is presented with the ability to control who may refer to and who may be referred to by there web page. However, Dutta discloses that when web pages links to another web page approval of this type of referral must be received from the linked web pages operator, and in turn the operator has the ability to allow referrals between the two pages (column 3, lines 20-45 and

column 7, line 52-column 8, line 60 of Dutta). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Dozier and Gentner with the teachings of Dutta because it would have allowed the content producers to selectively control referrals to and from their web pages.

Response to Arguments

9. Applicant's arguments with respect to claims 9-15, 26-28, 35-39, 50-52, 54, and 56-58 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 2178

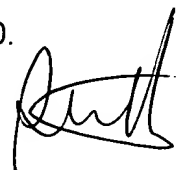
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua D. Campbell whose telephone number is (571) 272-4133. The examiner can normally be reached on M-F (7:30 AM - 4:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JDC
August 31, 2006



STEPHEN HONG
SUPERVISORY PATENT EXAMINER